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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,079	10/19/2001	Gholam A. Peyman	41082	7267

1609 7590 06/17/2003

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/982,079

Applicant(s)

Peyman

Examiner

J. Shay

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on May 22, 2002.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-21 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-21 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 203
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 3739

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Esperance, Jr. in combination with Warner et al and Yu et al. L'Esperance, Jr. teaches placing a lens implant on an exposed stromal surface and ablating the lens to the desired shape. Warner et al teach the desirability of producing a corneal flap, which is then replaced over a shaped stromal surface. Yu et al teach employing a robotic device to perform eye surgery. It would have been obvious to the artisan of ordinary skill to perform the method of L'Esperance, Jr. after forming a flap, since this preserves Bowman's layer, which is desirable, as taught by Warner et al and to perform various aspects such as the ablation, flap formation and implant placement using a robot, since this provides more accurate control, as taught by Yu et al, thus producing a method such as claimed.

Claims 1 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Esperance, Jr in combination with Warner et al and Yu et al as applied to claims 1-4 above, and further in view of Salz. Salz teaches that the optical axis of the flap must be marked and its position assured and that the flap is smoothed after being replaced in a keratomyleusis procedure. It would have been obvious to the artisan of ordinary skill to mark the flap, since proper repositioning is critical to the outcome of the surgery and to similarly mark the implant since, if this were not also properly positioned, the proper positioning of the cornea would be to no avail,

Art Unit: 3739

and to compress the corneal flap with a therapeutic contact such as a mild patch, since this maintains the corneal flap in position, thus producing a method such as claimed.

Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Esperance, Jr. in combination with Warner et al, Yu et al and Salz as applied to claims 1 and 5-8 above, and further in view of Galvanauskas et al. Galvanauskas et al teach the desirability of using ultrashort pulses to form corneal flaps. It would have been obvious to the artisan of ordinary skill to employ an ultrashort pulse laser to form the flap, since this provides a smooth cut, as taught by Galvanauskas et al, and to dispense the lens material using a plunger, since this is a notorious dispensing means in the medical field, is not critical, and provides no unexpected result, thus producing a method such as claimed.

Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Esperance, Jr. in combination with Warner et al, Yu et al, Salz, and Galvanauskas et al. The teachings of L'Esperance, Jr.; Warner et al; Yu et al; Salz; and Galvanauskas et al and the motivations for combination thereof are essentially those already set forth above. Thus it would have been obvious, for the reasons already elucidated, to combine these old well known teachings to produce a device such as claimed.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.



Shay/DI

June 5, 2003

DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330